

### **REMARKS**

In response to the Office Action dated July 7, 2009, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks.

Applicant appreciates the Examiner's comprehensive examination of the application. Applicant also appreciates the Examiner's provision of responses to Applicant's arguments to advance prosecution of the present application.

### **Status of the Claims**

Claims 1-2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72 and 75-85 are pending and examined in this Office Action. Claims 29-30, 32, 34-44 and 47-56 stand rejected under Section 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 29-30, 32, 34-44 and 47-56 stand rejected under Section 112 as failing to comply with the written description requirement. Claims 1-2, 4, 6-16, 19-30, 32, 34-44, 47-56 and 85 stand rejected under Section 101 on the grounds that the claimed invention is directed to non-statutory subject matter. Claims 1-2, 4, 6-15, 19-23, 29-30, 32, 34-43, 47-51, 58, 60, 62-71, 75-79 and 85 stand rejected under Section 103(a) as being unpatentable over U.S. Patent No. 6,374,241 to Lamburt (Lamburt) in view of Items U1-X7 cited in the PTO-892 (collectively referred to herein as "Superpages") and further in view of U.S. Patent No. 7,062,466 to Wagner et al. (Wagner).

### **The Rejections under Section 112**

Regarding the rejections of Claims 29-30, 32, 34-44 and 47-56 under Section 112, Applicant respectfully submits that the description in Applicant's specification in at least **Figures 3-6B** and page 6, line 8 to page 12, line 32 (considered in the context of the remainder of the specification) clearly set forth means for accomplishing the recited functions in terms that would enable any skilled person in the art to determine that which the Applicant regards as his invention and to make and use the claimed invention.



### **The Rejections under Section 101**

Applicant respectfully submits that the rejection under Section 101 is overcome by the present amendments to Claims 1 and 29 and in view of the "Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101" dated August 24, 2009 (available at [http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25\\_interim\\_101\\_instructions.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf)) (hereinafter "the Interim Examination Instructions"), which were issued by the USPTO to clarify recent developments in subject matter eligibility jurisprudence pending a final decision from the Supreme Court in *Bilski v. Kappos*. See the Interim Examination Instructions, page 1. Notably, the Interim Examination Instructions were released by the USPTO after the Action was issued and "supersede previous guidance on subject matter eligibility that conflicts with the Instructions, including MPEP 2106(IV), 2106.01 and 2106.02." See *id.*

### **The Rejections under Section 103**

Applicant again hereby incorporates by reference Applicant's arguments as set forth in Applicant's Responses dated October 19, 2007, September 9, 2008 and July 7, 2009. Applicant respectfully submits that those arguments apply to the current rejections as well. In particular, the ordinarily skilled artisan would not understand Lamburt to disclose or teach permitting a customer to configure a particular, unique, individualized, customized business listing and receiving an order request from the customer via the Web site to place an order for the customized business listing in the business directory as claimed. As best understood and discussed in the prior Responses, the Superpages reference itself teaches a method for enabling placement of an order in the context of Lamburt that requires interfacing with a sales representative. Traditionally, listing enhancements have been offered to customers through direct interactions or negotiations with sales representatives of the business directory offeror. Thus, the ordinarily skilled artisan in view of Lamburt, particularly in further view of Superpages, would expect that the only ordering options for listing enhancements in Lamburt would require interfacing with a sales representative.

In the Response to Arguments (Action at page 2), the Action states:



Despite the fact that the prior art clearly discloses purchasing ads online (see at least Lamburt figs. 3, 10-19, 21, 43-44, and column 5 lines 47-58) applicant continues to argue that the “purchase orders online” option does not actually mean that the ads can be purchased online, but that an “ordinarily skilled artisan” would rather interpret the disclosure to mean that the ordering options and actual purchase would only take place upon interaction with a sales representative. The examiner continues to find applicant’s arguments unpersuasive. In addition, even if applicant’s argument were accepted, the claims would read upon the prior art because there is nothing in them to distinguish them even from applicant’s interpretation of the prior art.

For the sake of clarification, Applicant notes that the deficiency of Lamburt is not that it does not suggest enabling a customer to order an ad online, but that it does not suggest enabling a customer to order a customized business listing including two or more independent optional listing enhancements via a Web site or enabling a vendor to solicit the customer to place, via the Web site, such an order. Claims 1, 29 and 57 have been amended to further reflect this distinction.

In the new grounds of rejection, Wagner (specifically: abstract; **Figures 1 and 35**; column 1, lines 20-40; column 2, lines 1-18; and column 5, line 54 to column 6, line 3) is cited as teaching the claimed steps of<sup>1</sup>:

soliciting at the Web site the customer to place an order via the Web site for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer; and

receiving an order request from the customer via the Web site to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

Applicant respectfully submits that Wagner does not cure the deficiency of Lamburt and Superpages. Although Wagner enables a customer to order an ad online, it does not appear to enable a customer to place an order online for a customized business listing including two or

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<sup>1</sup> These claim paragraphs have been further amended herein.



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more independent optional listing enhancements solicited and selected online. Rather, Wagner enables the entry of standard information such as name, address, phone number, super classification (*e.g.*, "automobile") and sub classification (*e.g.*, "Oldsmobile").

In view of the foregoing, Applicant respectfully submits that Claims 1, 29 and 57 are allowable over the cited art. Claims 2, 4, 6-16, 19-28, and 85 depend from Claim 1, Claims 30, 32, 34-44, and 47-56 depend from Claim 29, and Claims 58, 60, 62-72, and 75-84 depend from Claim 57, respectively, and these claims are therefore allowable as well for at least these reasons.

### **CONCLUSION**

Applicant respectfully submits that this application is now in condition for allowance, which action is requested. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



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### **CERTIFICATION OF ELECTRONIC TRANSMISSION**

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on September 24, 2009.

  
Katie Wu